

47512



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	PATENT
	:	
Klaus NÄGELE et al.	:	
	:	
Serial No.: 10/516,459	:	Art Unit: 3726
	:	
Filed: December 3, 2004	:	Examiner: R. K. Chang
	:	
For: METHOD FOR PRODUCTION OF	:	Appeal No. _____
A PRODUCTION FIXING PIECE	:	

**BRIEF ON APPEAL**

Mark S. Bicks, Esquire  
Roylance, Abrams, Berdo & Goodman, LLP  
1300 19<sup>th</sup> Street, N.W., Suite 600  
Washington, D.C. 20036  
(202) 659-9076

## TABLE OF CONTENTS

	Page
1. Real Party in Interest.....	1
2. Related Appeals and Interferences.....	2
3. Status of Claims .....	2
4. Status of Amendments .....	2
5. Summary of Claimed Subject Matter.....	2
6. Grounds for Rejection to be Reviewed Upon Appeal.....	3
7. Arguments.....	3
A. Rejections Under 35 U.S.C. §103(a) over Coffield and Schulte Patents.....	3
(1) The Rejection .....	3
(2) Claim 5.....	4
(3) Dependent Claims 6 and 8-10.....	7
B. Rejections Under 35 U.S.C. §103(a) over Coffield, Schulte and Bethe .....	8
(1) The Rejection .....	8
(2) Claim 7 .....	8
8. Conclusion .....	9

APPENDIX A – COPY OF CLAIMS ON APPEAL

APPENDIX B – EVIDENCE

APPENDIX C – RELATED PROCEEDINGS

47512



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	PATENT
	:	
Klaus NÄGELE et al.	:	
	:	
Serial No.: 10/516,459	:	Art Unit: 3726
	:	
Filed: December 3, 2004	:	Examiner: R. K. Chang
	:	
For: METHOD FOR PRODUCTION OF	:	Appeal No. _____
A PRODUCTION FIXING PIECE	:	

**APPELLANT BRIEF**  
**ON APPEAL UNDER 37 C.F.R. §41.37**

COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

For the appeal to the Board of Patent Appeals and Interferences from the decisions dated March 3, 2009 and May 4, 2009 of the Primary Examiner twice and finally rejecting claims 5-10 in connection with the above-identified application, Applicant-Appellant submits the following brief in accordance with 37 CFR §41.37.

1. Real Party in Interest

The inventors, Klaus Nägele and Axel Schulte, assigned their entire rights, titles and interests in the patent application to Gottlieb Binder & Co. KG of Holzgerlingen, Germany.

06/04/2009 SMOHANME 00000042 10516459

01 FC:1402

540.00 OP

2. Related Appeals and Interferences

There are no other related appeals or interferences known to Appellants, Appellants' legal representative, or assignees, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

3. Status of Claims

Claims 1-4 are cancelled. Claims 5-10 are pending, are rejected, and are on appeal.

4. Status of Amendments

Subsequent to the March 3, 2009 Office Action containing the final rejection, an April 22, 2009 Response was filed that did not seek to amend any claims. A May 4, 2009 Advisory Action considered the Response, but held that the Response did not place the application in condition for allowance.

5. Summary of Claimed Subject Matter

Claim 5 covers a method for producing a fixing piece to fasten cover materials on upholstery components 10 in seats (p. 6, lines 1-3; p. 7, lines 25-27; Figs. 1-3). The method comprises the steps of producing a profile component 12 with a mounting opening 34 therein predominantly from a first plastic material with a first melting point range, and producing a sew-on tag 36 separately from the profile component 12 and predominantly of a second plastic material with a second melting point range (p. 7, line 27, to p. 8, line 6). The first and second melting point ranges are different (p. 8, line 3). A portion of the sew-on tag 36 is located in the mounting opening 34 of the profile component 12 (p. 7, lines 27-29; Fig. 2). The profile component 12 and the sew-on tag 36 are subjected to thermal action so that one of the plastic

materials remains substantially stable, while the other of the plastic materials penetrates recesses 38 in the one of the plastic materials (p. 8, lines 3-6; Fig. 3). The plastic materials of the profile component 12 and the sew-on tag 36 are cooled such that the other plastic material solidifies in the recesses to bond the profile component 12 and the sew-on tag 36 (p. 8, lines 6-12; Figs. 2-3).

By performing the method in this manner, particularly by heating plastic material parts with different melting point ranges, the fixing piece can be formed rapidly and at low cost in an environmentally friendly way. No application of an adhesive is needed. Additionally, a very strong bond is formed between the profile and the sew-on tag.

6. Grounds for Rejection to be Reviewed Upon Appeal

Claims 5-6 and 8-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,511,562 to Coffield in view of U.S. Patent No. 6,478,382 to Schulte.

Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over the Coffield and Schulte patents in view of U.S. Patent No. 4,197,342 to Bethe.

7. Arguments

A. Rejections Under 35 U.S.C. §103(a) over Coffield and Schulte Patents

(1) The Rejection

Claims 5-6 and 8-10 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,511,562 to Coffield in view of U.S. Patent No. 6,478,382 to Schulte. The Coffield patent is cited for a profile 14, 16 with an opening 22, 24 and a tag 18 made separately from the profile and formed of elastomeric monofilaments. The profile and the tag are alleged to be made of two plastic materials (the Hytrel or PVC of strip halves 14 and 16 and the urethane adhesive)

with different melting point ranges. The profile is allegedly located in the opening and is allegedly subjected to thermal action by the curing of adhesive 20 so that one of the plastic materials remains substantially stable while the other material 20 penetrates recesses in the stable plastic material followed by cooling. The Schulte patent is cited for the use of a sew-on tag, with the allegation that making the Coffield tag a sew-on tag would be obvious. Relative to claim 6, the Coffield patent is relied upon for first material that is extrudable and a tag of non-woven material. Relative to claim 8, the Coffield profile is again relied upon as being extruded, with the mounting of the tag in the opening being immediately after extrusion, as allegedly shown in Coffield Fig. 2. Relative to claims 9 and 10, Coffield column 6, lines 3-4, is cited for an adhesive having a melting point range greater than a first melting point range.

(2) Claim 5

Claim 5 is patentably distinguishable over the cited patents by this heating of the claimed plastic profile component and plastic sew-on tag with different melting point ranges such that one penetrates recesses in the other to bond same upon cooling.

The Office Action is apparently relying on the fact that the Coffield adhesive 20 is disclosed to be a hot melt adhesive so as to involve some thermal action. However, the claims require thermal action on the profile component and sew-on tag such that a first one remains stable while the other penetrates recesses in the first one. The Coffield adhesive 20 is neither part of the Coffield strips 14 and 16 alleged to correspond to the claimed profile component nor the Coffield fabric 18 with elastomeric monofilaments alleged to correspond to the claimed tag. Since the adhesive 20 is not part of either the strip halves 14 and 16 or the fabric 18, the action of that adhesive does not satisfy the claimed method steps that only involve the profile component and the sew-on tag, without reciting the use of an adhesive.

The Coffield patent does not disclose heating a profile component with a sew-on tag therein, as claimed, since only adhesive 20 is heated in the Coffield patent. As described in column 6, lines 30-48 of the Coffield patent, lower bonding strip halves are placed in a fixture and then receive a bead of adhesive after the adhesive has been heated. The fabric then is placed onto the fixture with its peripheral edges in adhesive 20. The upper bonding strip halves 14 are then placed atop fabric 18 above lower bonding strip halves 16. Clamping holds the fabric between the upper and lower bonding strip halves until the adhesive is cured. Thus, the Coffield method does not apply heat to a profile component with a sew-on tag therein.

The claims also require different melting temperature ranges of the profile and the tag. In contrast, the Office Action only compares the material of the Coffield halves 14 and 16 with the adhesive, and not with the fabric.

The rejection involves a misinterpretation of the Coffield patent. The Coffield patent only discloses binding fabric 18 with bonding strip halves 14 and 16 by a heated adhesive 20. No disclosure of thermal action (heating) or of relative melting points is provided. The Coffield patent merely discloses the use of conventional urethane adhesive or other conventional adhesives. Such disclosure does not involve the use of thermal action on a profile component with a sew-on tag in the component mounting opening, where the melting point range of the profile 14, 16 is different than that of the fabric 18.

The Schulte patent is not cited for and does not cure this deficiency in the Coffield patent.

When no reference discloses a feature of a claim relied on to distinguish the prior art, there can be no suggestion to modify the prior art to contain that feature. In re Civitello, 339 F.2d 243, 144 USPQ 10 (C.C.P.A. 1964). As stated in W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 220 USPQ 303, 311 (Fed. Cir. 1983), there must be something in the

teachings of the cited patents to suggest or to provide a reason to one skilled in the art that the claimed invention would be obvious.

The Coffield patent relates to a bonding strip for a load bearing fabric mounted under load in a surrounding frame. The Schulte patent relates to a sew-on tag attached to a profile along one side of the tag only without a surrounding frame. In view of the significant differences in the subject matters of these two patents and the lack of any reason in these two cited patents relied upon for the proposed combination, a *prima facie* case of obviousness is lacking.

Despite the simple concept of the invention, the Examiner has the burden of finding “the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination in the manner claimed.” See In re Werner Kotzab, 217 F.3d 1365, 1371, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000). Here, the necessary factual findings are missing, rendering the rejection untenable.

The Examiner, in this situation has not pointed to any specific principle or motivation in the prior art that would lead one skilled in the art to arrive at the invention as claimed.

“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” In re Werner Kotzab, 217 F.3d at 1371, 55 USPQ 2d at 1318. If no particular finding can be made as to the reason one skilled in the art would have replaced the Coffield fabric 18 with the Schulte connection strip 35, the Examiner cannot hold the invention obvious.

Accordingly, claim 5 is patentably distinguishable over the cited patents.



(3) Dependent Claims 6 and 8-10

Claims 6 and 8-10, being dependent upon claim 5, are also allowable for the above reasons. Moreover, these dependent claims recite additional features further distinguishing them over the cited patents.

(a) Claim 6

Claim 6 is further distinguishable by the first plastic material being extrudable, and the sew-on tag 36 being a non-woven material, a formed fabric or an open-pore woven material that is retained in a profile component by the claimed method steps. Such is not disclosed in the Coffield and Schulte patents.

(b) Claim 8

Claim 8 is further distinguishable by the profile component 12 being extruded, by the sew-on tag 36 being bonded to the profile component 12 by being mounted in the mounting opening 34 immediately after extrusion of the profile component or simultaneously with extrusion of the profile component 12, and by the wall components 40 of the profile component 12 adjoining the mounting opening 34 and a portion of the sew-on tag 36 in the mounting opening 34 being pressed together to penetrate the other plastic material into the recesses 38. Although Fig. 2 of the Coffield patent is cited for these features, the Coffield fabric is not disclosed to be and cannot be placed between halves 14 and 16 immediately after or simultaneously with extrusion, since the halves must be fully formed to receive adhesive 20 in bonding grooves 26 and be mounted in the fixture (see column 6, lines 30-48). Particularly, Coffield Fig. 2 does not show any relationship of strip halves 14 and 16 and fabric 18 relative to

extrusion of those strip halves. Also, column 6, lines 30-48 disclose a different method, as noted above.

(c) Claim 9

Claim 9 is further distinguishable by the second melting point range being greater than the first melting point range. The adhesive 20 does not comprise the plastic of the Coffield halves 14 and 16 or its fabric 18, and thus, cannot teach this feature.

(d) Claim 10

Claim 10 is further distinguishable by the second melting point range being greater than the first melting point range. The adhesive 20 does not comprise the plastic of the Coffield halves 14 and 16 or its fabric 18, and thus, cannot teach this feature.

B. Rejections Under 35 U.S.C. §103(a) over Coffield, Schulte and Bethe

(1) The Rejection

Claim 7 stands rejected under 35 U.S.C. §103 as being unpatentable over the Coffield and Schulte patents, when further considered in view of U.S. Patent No. 4,197,342 to Bethe. The Bethe patent is cited for the use of particular materials.

(2) Claim 7

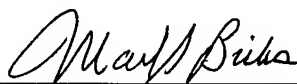
Claim 7 is distinguishable for the reasons advanced above relative to claims 5-6, and is further distinguishable by the plastic material being a soft polyvinyl chloride material or a polypropylene block material, and that the second plastic material being a polyester non-woven material. The Bethe patent, in relating to a foaming process, is not analogous to and is not

properly combinable with the adhesive bonding of the Coffield patent, since the cited patents do not provide a teaching or reason for the proposed combination.

8. Conclusion

In view of the foregoing, the rejections of the claims are untenable and reversal thereof is requested.

Respectfully submitted,



---

Mark S. Bicks  
Reg. No. 28,770

Roylance, Abrams, Berdo & Goodman, LLP  
1300 19th Street, NW, Suite 600  
Washington, DC 20036  
(202) 659-9076

Dated: June 3, 2009

## APPENDIX A – COPY OF CLAIMS ON APPEAL

5. A method of producing a fixing piece to fasten cover materials on upholstery components in seats, comprising the steps of:

producing a profile component with a mounting opening therein predominantly from a first plastic material with a first melting point range;

producing a sew-on tag separately from the profile component and predominantly of a second plastic material with a second melting point range, said first and second melting point ranges being different;

locating a portion of the sew-on tag in the mounting opening of the profile component;

subjecting the profile component and the sew-on tag to thermal action so that one of the first and second plastic materials remains substantially stable while the other of the first and second plastic materials penetrates recesses in the one of the first and second plastic material; and

cooling the plastic materials of the profile component and the sew-on tag such that the other of the first and second plastic materials solidifies in the recesses to bond the profile component and the sew-on tag.

6. A method according to claim 5 wherein

the first plastic material is extrudable; and

the sew-on tag comprises one of a non-woven material, a formed fabric and an open-pore woven material.

7. A method according to claim 6 wherein

the first plastic material is at least one of soft polyvinyl chloride material and a polypropylene block material; and

the second plastic material comprises a polyester non-woven material.

8. A method according to claim 5 wherein

the profile component is extruded;

the sew-on tag is bonded to the profile component by being mounted in the mounting opening at one of immediately after extrusion of the profile component and simultaneously with extrusion of the profile component; and

wall components of the profile component adjoining the mounting opening and the portion of the sew-on tag in the mounting opening are pressed together to initiate penetration of the other of the first and second plastic materials into the recesses.

9. A method according to claim 8 wherein

said second melting point range is greater than said first melting point range.

10. A method according to claim 5 wherein

said second melting point range is greater than said first melting point range.

## APPENDIX B - EVIDENCE

None.

APPENDIX C – RELATED PROCEEDINGS

None.